

Inventor: Glen A. Evans
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- Group VII: Claims 12 (in part), 14, 18 (in part) and 20, directed to methods of diagnosing or predicting a bipolar disorder using as a probe SEQ ID NO:3;
- Group VIII: Claims 12 (in part), 15, 18 (in part) and 21, directed to methods of diagnosing or predicting a bipolar disorder using as a probe SEQ ID NO:5;
- Group IX: Claims 12 (in part), 16 and 17, directed to a method of diagnosing or predicting a bipolar disorder using as an antibody against a polypeptide encoded by SEQ ID NO:3;
- Group X: Claims 18 (in part) and 22 through 24, directed to a method of diagnosing or predicting a bipolar disorder using as an agent that binds to a mannosyl transferase of SEQ ID NO:2;
- Group XI: Claims 18 (in part) and 25 through 30, directed to a method of diagnosing or predicting a bipolar disorder by measuring activity of a mannosyl transferase; and
- Group XII: Claims 33 through 35, directed to a non-human transgenic animal.

The Examiner also states that the invention of Groups V is generic to a plurality of patentably distinct species, in particular, SEQ ID NOS: 16-117. Therefore, if Applicant elects Group V, the Office requires election of a species of a single disclosed species selected from SEQ ID NOS: 16-117.

Election of Invention

Applicant traverses the Restriction and Election of Species requirements for the reasons stated below. Nevertheless, in order to be responsive to the Office Action, Applicant provisionally elects the invention of Group I, claims 1, 2, 31 and 32, directed to a polypeptide of SEQ ID NO:2 and a method of use thereof. Since Applicant does not elect Group V, the Election of Species requirement has been rendered moot at this time.

The Restriction Requirement is traversed with respect to the division of the claims of Group I from the claims of Group X. Applicant respectfully points out that two separate

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requirements must be met in order for restriction to be proper. First, the inventions must be independent or distinct. Secondly, there must be a serious burden on the Examiner if restriction is required. See, for example, MPEP 803 (Restriction- When Proper), which states, in part:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Page 800-3; emphasis added.

Thus, it is not sufficient for an Examiner to assert that patentably distinct inventions are present in order to restrict an application. There also must be a serious burden on the Examiner to search and examine the entire application. For the reasons set forth below, Applicant respectfully submits that the burden of searching and examining the method claims of Groups I and X together has not been sufficiently established for the restriction to be proper.

Regarding Restriction of Group I from Group X

Applicant submits that, while the claims of Group X are patentably distinct from the claims of Group I, a thorough search of the elected claims of Group I, directed to a polypeptide of SEQ ID NO:2 and a method of identifying a compound that modulates the activity a mannosyl transferase, likely will result in art relevant to examination of the claims of Group X, directed to a method of diagnosing or predicting a bipolar disorder using as an agent that binds to a mannosyl transferase of SEQ ID NO:2. As is supported by their classification in the same class (435), a thorough search of the elected methods of Group I likely will result in art relevant to examination of the methods of Group X. Therefore, it would not present a serious burden for the Examiner to additionally search and examine the compositions and methods of Group I with the related subject matter of elected Group X.

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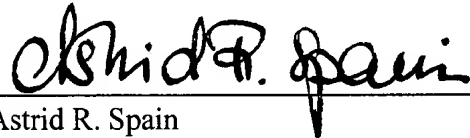
CONCLUSION

In view of the remarks submitted herein, Applicant provisionally elects the claims of Group I. Applicant further requests that the Examiner reconsider the Restriction Requirement and also examines the method claims of Group X (claims 18 (in part) and 22-24) along with the composition and method claims of elected Group I (claims 1, 2, 31 and 32). The Examiner is invited to call the undersigned attorney if there are any questions regarding this application.

Respectfully submitted,

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